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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Docket ATM-2273

Applicants : Hans-Rudolf Nägeli et al.

Serial No. : 09/726,372 Art Unit: 1762

Filed : 12/01/2000 Examiner: Elena Tsoy

For : PROCESS FOR THE PRODUCTION OF A
PLASTIC-COATED ALUMINIUM FOIL AND
PACKAGING MADE FROM THIS

Letter Requesting Issuance Of A New Office Action

Commissioner for Patents
Washington, D.C. 20231

Sir:

Applicants request that the Office Action dated January 9, 2003 be withdrawn and a new Office Action that enters Claims 28 to 54 be issued in its place. (This letter is not a response on the merits to the said 1/9/2003 Office Action.)

The Office Action dated January 9, 2003 incorrectly refused to enter Claims 28 to 54 on the ground that independent Claim 28 contained new matter. Page 2 of said 1/9/03 Office Action states:

"The Amendment of claims filed on November 26, 2000 has not been entered since it introduces into independent claim 28 a new matter such as the temperature at the surface of the plastic coating and the adhesion-promotion agent lying **below** the crystallite melt point (Tk) of the plastic before heating in an oven.

Amended claims 29-54 have not been entered since they depend on claim 28."

The examiner's refusal to enter Claims 28 to 54 on the ground that independent Claim 28 contains new matter is in contravention of the pertinent practice set out in the M.P.E.P. Also, the examiner did not even present any reason (other than that allegedly new matter was involved, which is not sufficient) in an attempt to support the noncompliance with the M.P.E.P. procedure.

Section 714.19 of the M.P.E.P. states:

"The following types of amendments are ordinarily denied entry:

* * *

(J) Amendments to the drawing held by the examiner to contain new matter are not entered until the question of new matter is settled. This practice of nonentry because of alleged new matter, however, does not apply in the case of amendments to the specification and claims. See MPEP § 608.04 and § 706.03(o)."

[Emphasis supplied] [Pages 700-194 and 700-195]

Accordingly, applicants request the withdrawal of the Office Action dated January 9, 2003 and the issuance of a new Office Action that enters correctly Claims 28 to 54.

Applicants submitted Claims 28 to 54 in response to the earlier non-final Office Action.

The proper procedure would have been to enter Claims 28 to 54 and then reject them under 35 U.S.C. 112. Section 608.04 of the M.P.E.P. states:

"While amendments to the specification and claims involving new matter are ordinarily entered, such matter is required to be canceled from the descriptive portion of the specification, and the claims affected are rejected under 35 U.S.C. 112, first paragraph."

"When new matter is introduced into the specifications, the amendment should be objected to under 35 U.S.C. 132 (35 U.S.C. 251 if a reissue application) and a requirement made to cancel the new matter. The subject matter which is considered to be new matter must be clearly identified by the Examiner. If the new matter has been entered into the claims or affects the scope of the claims, the claims affected should be rejected under 35 U.S.C. 112, first paragraph, because the new matter is not described in the application as originally filed." [Emphasis supplied] [Page 600-107]

Section 608.04(a) of the M.P.E.P. states:

"For rejection of claim involving new matter, see M.P.E.P. §706.03(o)." [Page 600-108]

Section 706.03(o) of the M.P.E.P. states:

"In amended cases, subject matter not disclosed in the original application is sometimes added and a claim directed thereto. Such a claim is rejected on the ground that it recites elements without support in the original disclosure under 35 U.S.C. 112, first paragraph, *Waldmar Link, GmbH & Co. v. Ostenoics Corp.* 32 F. 3d 556, 59, 31 USPQ2d 1855, 1857 (Fed. Cir. (1994); *In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981)."

[Emphasis supplied] [Page 700-52]

Section 2163.06 of the M.P.E.P. states:

"If new subject matter is added to the disclosure, whether it be in the abstract, the specification, or the drawings, the examiner should object to the introduction of new matter under 35 U.S.C. 132 or 251 as appropriate, and require applicant to cancel the new matter. If new matter is added to the claims, the examiner should reject the claims under 35 U.S.C. 112, first paragraph – written description requirement. *In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981). The Examiner should still consider the subject matter added to the claim in making rejections based on prior art since the new matter rejection may be overcome by applicant."

"In an instance in which the claims have not been amended, *per se*, but the specification has been amended to add new matter, a rejection of the claims under 35 U.S.C. 112, first paragraph should be made whenever any of the claim limitations are affected by the added material."

[Emphasis supplied] [Page 2100-172]

Compliance with the pertinent procedure set out in the M.P.E.P. is requested.

Respectfully submitted,



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Date: Jan. 21, 2003

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